

Serial No. 09/757,454

Attny Ref. 2000-0163

**REMARKS**

Reconsideration and allowance are requested. Claims 1-10 are pending.

Applicant requests withdrawal of the finality of the present Office Action and upon such withdrawal, Applicant requests entry of the new claims 11-16.

**Withdrawal of the Finality of the Outstanding Office Action**

Applicants respectfully request that the Examiner withdraw the finality of the present Office Action as premature. This is the second Office Action in the case and under Section 706.07 of the MPEP, it is appropriate to make final the second Office Action when the invention is disclosed and claimed, and the prior art is fully searched and applied. Before a final rejection is in order a clear issue should be developed between the Examiner and the Applicant.

In the first Office Action, the Examiner cited and discussed U.S. Patent No. 4,757,525 issued to Matthews et al. to reject the claims. In the accompanying PTO-892 form, the Matthews patent, U.S. Patent No. 6,208,966 to Andrew Bulfer and U.S. Patent No. 6,229,880 were listed. In response, Applicant amended some of the claims and argued that Matthews et al. should preclude patentability of the claims.

In the Second Office Action, the Examiner has applied a new prior art reference: U.S. Patent No. 5,805,672 to Barkat et al. (the "672 patent" or the "Barkat et al." patent). The Examiner incorrectly refers to this patent as issued to "Bulfer et al." Applicant notes that in the PTO 892 form accompanying the second Office Action, the '672 patent is not listed but the previously cited '966 Bulfer patent is cited again. Applicant requests a new PTO-892 form correctly citing the '672 patent.

Substantively, the Examiner has switched the applied prior art from the Bulfer patent to the '672 patent, which "tends to defeat the goal of reaching a clearly defined

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issue for an early termination, i.e., either an allowance of the case or a final rejection?"

MPEP 706.07. Since no clearly defined issue exists at this time in prosecution due to this being the first rejection based on the '672 patent, Applicant respectfully submits that the finality of the rejection is premature and should be withdrawn.

### Rejection of Claims 1-10 Under Section 102

The Examiner rejects claims 1-10 under Section 102 (e) as being anticipated by the '672 patent to Barkat et al. Applicant respectfully traverses this rejection and submits that Barkat et al. do not anticipate or teach each element of the claims.

Claim 1 recites a voice-operated arrangement for interacting with a DTMF-controlled system. The Examiner asserts that column 3, lines 25 - column 4, lines 41 disclose the limitation of:

retrieving dial-out information for a DTMF-controlled system associated with the user and completing a communication path between the user and said associated DTMF-controlled system, wherein said voice-operated arrangement monitors the communication path and retrieves predetermined voice commands uttered by the user and translates said predetermined voice prompts into DTMF tones which are thereafter transmitted to said associated DTMF-controlled system.

Applicant asserts, however, that there are several limitations recited in this phrase that are not taught by Barkat et al. Barkat et al. essentially teaches a "call Mom" hands free system, wherein the user can store a phone number for "Mom" and then retrieve and call that phone number via saying "call Mom." There is no disclosure of retrieving dial-out information for a DTMF-controlled system associated with the user. When a generic number is dialed in Barkat et al., it is simply an outgoing telephone call to a person. There is no indication that the outgoing call is to a DTMF-controlled system that is associated with the user in any way.

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Further, Barkat et al. fail to disclose or suggest, once the communication between the user and the DTMF-controlled system is established, monitoring the communication path and retrieving predetermined voice commands uttered by the user to translate the predetermined voice prompts into DTMF tones that are transmitted to the associated DTMF-controlled system. Again, the portion of Barkat et al. cited by the Examiner merely teaches a process of enabling a user to say words like "call Mom" to prompt the system to retrieve and dial the associated phone number.

Accordingly, Applicant respectfully submits that claim 1 is patentable over Barkat et al. and that this claim is in condition for allowance.

Claims 2-7 each depend from claim 1 and recite further limitations therefrom. Applicant submits that claim 1 provides ample reasons for patentability and therefore the dependent claims are patentable as well.

Claim 8 is a method claims that is rejected also by reference to Barkat et al., column 3. Applicant submits that there are numerous elements not taught by Barkat et al. For example, element c) recites dialing out to a DTMF-controlled system included in the user record retrieved in step b). Barkat et al. fail to disclose or suggest dialing out to a DTMF-controlled system included in the user record retrieved in step b). As discussed above, Barkat et al. only disclose obtaining a telephone number from memory associated with a voice command like "call Mom" and dialing out that phone number. For these and other reasons, Applicant submits that claim 8 is patentable over the prior art of record.

Claim 9 and claim 10 each depend from claim 8 and recite further limitations therefrom. Accordingly, Applicant submits that these claims are patentable as well and are in condition for allowance.

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**New Claims 11-16**

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Applicant submits that new claims 11 - 16 also recite limitations not taught by the prior art of record and requests a Notice of Allowance for these claims as well as claims 1 - 10.

**CONCLUSION**

Having addressed the rejection of claims 1 - 10 and requested entry of claims 11 - 16, Applicant respectfully submits that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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